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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/559,128      | 04/28/2000  | Yasushi Kurosawa     | P19379              | 3104             |

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EXAMINER

CRAIG, DWIN M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2123

DATE MAILED: 09/11/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/559,128

Applicant(s)

KUROSAWA ET AL.

Examiner

Dwin M Craig

Art Unit

2123

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 April 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1-16 have been presented for examination. Claims 1-16 have been examined and rejected.

#### **Claim Rejections - 35 USC § 101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1-6** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**2.1** **Claims 1-6** recite a computer program product. It should be noted that code (i.e., a computer software program) does not do anything per se. Instead, it is the code stored on a computer that, *when executed*, instructs the computer to perform various functions. The following claim is a generic example of a proper computer program product claim;

A computer program product embodied on a computer-readable medium and comprising code that, when executed, causes a computer to perform the following:

Function A

Function B

Function C, etc...

#### **Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claim 1** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Specifically, the Examiner is unable to determine what the phrase, "*making the character controlled in accordance with operations of the player use an item;*" is supposed to mean. The Examiner is unable to determine if the *character* is supposed to be controlled by the *player* or controlled by the *item*.

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kobayashi et al. U.S. Patent 6,488,586** in view of "**Advanced Dungeons&Dragons® Players Handbook 2<sup>nd</sup> Edition**" by Steve Winter and Jon Pickens, hereafter referred to as the *Winter et al.* reference, and in further view of "**Advanced Dungeons&Dragons® Dungeon Masters Guide**" by Gary Gygax, hereafter referred to as the *Gygax* reference.

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4.1 As regards independent Claims 1, 7 and 13 the *Kobayashi et al.* reference discloses a computer readable program product for storing a game program (**Figures 1, 21 and 22, Col. 1 Lines 35-45, Col. 3 Lines 57-67, Col. 4 Lines 1-29**), *that when* the game program is *executed on a processor*, allows for the creation of a character (**Figures 2**) with at least one ability (**Figure 2 Items 104a and 104b**) and at least one item (**Figure 2 Items 104c and 104d**) and judging whether the level of mastery of at least one ability of at least one item satisfies a predetermined condition (**Figures 2-15, Col. 4 Lines 55-67, Col. 5 Lines 1-48, Col. 6 Lines 47-59**).

However, the *Kobayashi et al.* reference does not expressly disclose that when the level of mastery, of at least one ability, satisfies a predetermined condition, the character is given the ability, linked to an item, to enable use of the item with subsequent operations of the player.

The *Winter et al.* reference discloses that when the level of mastery of a character, that at least one ability of the character, satisfies a predetermined condition, and the character is given the ability to perform better (**Chapter 8: Experience, pages 88-89 and Chapter 9: Combat, specifically pages 89-91 "CALCULATED THAC0S**).

It would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to have modified the *Kobayashi et al.* reference with the *Winter et al.* reference because, by improving the characters experience and abilities in a role playing game a user will want to play the game more and more in the hopes of being rewarded with greater levels of abilities, (**Advanced Dungeons&Dragons® Player's Handbook, 2<sup>nd</sup> Edition, page 88**).

The *Gygax* reference discloses enabling the use of an "*item*" that enables special abilities in a character (**TREASURE-Miscellaneous Magic-Swords pages 165-169**).

It would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to have modified the *Kobayashi et al.* reference with the *Gygax* reference because, using magic items in a role playing game enhances the ability of a character to gain experience and thus improve the characters effectiveness in the role playing world which motivates the player to want to play the game more.

**4.2** As regards dependent **Claims 2, 8 and 14** the *Kobayashi et al.* reference discloses protective gear (**Figure 2 Item 104c**) and a weapon (**Figure 2 Item 104d**).

**4.3** As regards dependent **Claims 3, 9 and 15** the *Kobayashi et al.* reference does not expressly disclose “*experience points*.”

The *Winter et al.* reference discloses “*experience points*” (**Chapter 8: Experience, pages 88-89**).

It would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to have modified the *Kobayashi et al.* reference with the *Winter et al.* reference because, by improving the characters experience and abilities in a role playing game a user will want to play the game more and more in the hopes of being rewarded with greater levels of abilities, (**Advanced Dungeons&Dragons® Player’s Handbook, 2<sup>nd</sup> Edition, page 88**).

**4.4** As regards dependent **Claims 4, 10 and 16** the *Kobayashi et al.* reference does not expressly disclose awarding “*victory points*.”

The *Winter et al.* reference discloses awarding “*victory points*” (**Chapter 8: Experience, page 88 “Individual Experience Awards”**).

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It would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to have modified the *Kobayashi et al.* reference with the *Winter et al.* reference because, by improving the characters experience and abilities in a role playing game a user will want to play the game more and more in the hopes of being rewarded with greater levels of abilities, (**Advanced Dungeons&Dragons® Player's Handbook, 2<sup>nd</sup> Edition, page 88**).

4.5 As regards dependent **Claims 5, 6, 11 and 12** the *Kobayashi et al.* reference does not expressly disclose the use of *Magic*.

The *Gygax* reference discloses the use of *Magic* (**TREASURE-Miscellaneous Magic-Swords pages 165-169**).

It would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to have modified the *Kobayashi et al.* reference with the *Gygax* reference because, using magic items in a role playing game enhances the ability of a character to gain experience and thus improve the characters effectiveness in the role playing world which motivates the player to want to play the game more.

### **Conclusion**

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

5.1 Ultima Reference Card, this reference discloses a computer based role-playing system with items for characters.

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5.2 There are several role-playing computer games involving player characters improving during the game due to combat experience and the use of magic items, specifically, *Baldur's Gate*<sup>TM</sup> and *Diablo*®.

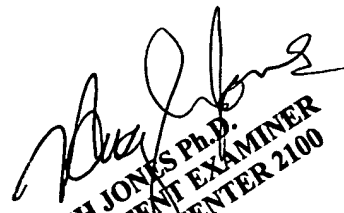
5.3 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwain M Craig whose telephone number is 703 305-7150.

The examiner can normally be reached on 9:00 - 5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Teska can be reached on 703 305-9704. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-3900.

DMC

  
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